

Amendment in response to an
April 2, 2007 Office action

Atty Dkt No.: 2001P18373US
Serial No.: 10/032,889

RECEIVED
CENTRAL FAX CENTER

JUN 26 2007

REMARKS

Claims 1, 3 – 11, 13 – 16 and 20 remain in the application and stand finally rejected. Claims 2, 6 and 17 – 19 are previously canceled. New claims 21 and 22 are added. No new matter has been added. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

New claims 21 and 22 are added and supported by claim 6. No new matter has been added. No reference of record shows or suggests a VPCN with remotely connected devices having access to the recited features of claims 6, 21 and 22. Consideration and allowance of claims 21 and 22 is respectfully requested.

Claims 1, 3 – 5, 9 – 11, 15, 16 and 20 are rejected as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,020,915 to Bruno et al. in view of U.S. Patent No. 5,619,555 to Fenton et al. Claims 7, 8, 13 and 14 are rejected under 35 U.S.C. §103(a) over Bruno et al. and Fenton et al. in view of published U.S. Patent Application No. 2001/0026609 to Weinstein et al. The rejection is respectfully traversed.

It is asserted that, essentially, Bruno et al. Figure 1 shows the invention as recited in claim 1 in elements 101 – 104, 118 – 120, 130, 135, 136 and 138 and as described in column 3, lines 46 – 64, column 4, lines 47 – 61 and column 5, lines 17 – 23 and 50 – 59, except that it is acknowledged that Bruno et al. fails to teach that “the remotely connected device controls the remote telephone.” Thus, Fenton et al. is relied upon to teach this missing element. In retracting the previous finding that canceled claim 2 (now claim 1), for example, is directed to patentable subject matter; the Office action concludes that “[t]he combination of a remote device and remote telephone taught by Bruno and Fenton **therefore must be defined as a virtual digital telephone**” (emphasis added). In other words, the Office action asserts that a virtual digital telephone is inherent in the combination of Bruno et al. and Fenton et al.

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Inherency has no place in a rejection under 35 U.S.C. §103(a). “The express, implicit, and **inherent disclosures** of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103.” MPEP §2112 (emphasis added), *see also*, the title of paragraph III. “(T)he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on ‘**inherency**’ under 35 U.S.C. 102, on ‘**prima facie obviousness**’ under 35 U.S.C. 103, jointly or alternatively,” *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). MPEP §2112 V. (emphasis added). Thus, for inherency to apply, all of the alleged inherent elements are not suggested by the combination, but must be disclosed in a single reference, substantially as claimed. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)” MPEP §2112 IV. (emphasis in original). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). *Id.* (emphasis in original, parenthetical omitted). Since the present invention is not rejected under 35 U.S.C. §102, but under 35 U.S.C. §103, Bruno et al. and Fenton et al. are available as a references, only for what each actually shows, not for what may be inherent in the combination.

As provided in the present application, “[o]nce connected and logged in, the client application is treated as any other locally connected (i.e., connected directly to the LAN) digital phone.” Page 4, lines 4 – 6. Moreover, “[t]he hybrid connection of the TAPI interacting with the communications server 102 of Figure 1 in combination with a low speed voice connection, e.g., the land line telephone 118 or the cell phone 120, effectively, is a **virtual digital telephone** and the network 100 is a virtual private communications network.” *Id.* lines 13 – 16 (emphasis added). As a result, each “connected remote user may direct communications through communications server 102 **nearly identically to on-site** and locally connected users.” *Id.* lines 16 – 19 (emphasis added). So for example, a telecommuting “remote user may initiate an in-system conference call from the remote location.” *Id.* lines 19 – 20. “Such a hybrid conference call is made in cooperation with a web server or WAP server to provide remote users with full

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access to the communications server features, ... server for a **virtual digital phone** connection.”

Page 6, lines 32 – 36 (emphasis added). Neither Bruno et al. or Fenton et al. shows this and, therefore, neither Bruno et al. nor Fenton et al. shows a virtual digital telephone. Therefore, a virtual digital telephone is not inherent in the combination of Bruno et al. and Fenton et al.

Instead, as previously noted, Bruno et al. teaches a telecommunications network with multimedia terminals 101, 102, 103 and 104. Col. 3, lines 46 – 47. The Bruno et al. telecommunications network also includes a multimedia platform 135 that “enables a user at an analog voice-only endpoint ... to communicate with and interact with these multimedia terminals on a video teleconference in a pseudo multimedia mode.” Col. 4, lines 47 – 61. Specifically, “user at telephone station 136 with only POTS service, and who also has a conventional data transmitter/receiver, such as a facsimile machine or a modem-connected PC terminal, is able to participate, albeit in a **reduced fashion**, in a pseudo multimedia manner with one or more of the multimedia endpoints in a videoconference arrangement or in a one-to-one connection.” Col. 5, lines 17 – 24 (emphasis added). Operating “in a pseudo multimedia manner” is not operating as a virtual digital telephone, substantially as described in the application.

Bruno et al. also describes sharing documents between multimedia terminals 101, 102, 103 and 104 and the facsimile machine 137 or modem-connected PC terminal 138 in a conference call. Col. 5, line 41 – col. 6, line 64. Specifically, “a document in the form of a data signal from one of the multimedia terminals to be shared with the voice-only user at telephone 136 is outputted by MCU 124 over LAN 145 to server 146 where it is stored” col. 5, lines 45 – 49; and, “if the voice-only user at telephone set 136 intends to share a document with the users at the multimedia terminals in the videoconference, facsimile machine or PC terminal establishes a telephonic connection” for the facsimile machine 137 or PC terminal 138 and the data is transferred and stored on the server. *Id.*, lines 59 – 66. Moreover, Bruno et al. teaches some embodiments where connection by the analog phone 136, facsimile machine 137 and modem-connected PC terminal 138 are mutually exclusive. *See, e.g.*, col. 7, line 62 – col. 8, line 3. Clearly, mutually exclusive devices sharing the same connection is not operating as a virtual digital telephone, substantially as described in the application and instead, teaches away from such a phone.

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As also previously noted, Fenton et al. teaches "an audio conferencing system 10 having a central server 12 connected through a LAN 14 to a pair of remote computers or workstations 16 and 18 and through a telephone network 20 to a pair of remote telephone sets 22 and 24. The telephone sets are **not** directly associated with the remote computers." Thus, since they are not associated, the remote computers or workstations 16 and 18 do not control the remote telephone sets 22 and 24. Again, because the remote computers or workstations 16 and 18 do not control the remote telephone sets 22 and 24, they are not operating as a virtual digital telephone, substantially as described in the application.

Instead, "[e]ach remote computer runs a GUI program which allows a user operating the remote computer to control the central server to provide information regarding **audio conferences** and to control other **audio conference functions**." Fenton et al. col. 5, lines 25 – 28 (emphasis added). The remote terminal can be used to join a conference call from the GUI and the system determines whether to connect an identified phone to the conference. *Id.*, lines 28 – 46. Neither is this operating as a virtual digital telephone, substantially as described in the application. Therefore, the combination of Bruno et al. and Fenton et al. does not result in the present invention as recited in claim 1.

Further, since dependent claims include all of the differences with the references as the claims from which they depend, claims 3 – 6, which depend from claim 1 are patentable over the combination of Bruno et al. and Fenton et al. Reconsideration and withdrawal of the rejection of claims 1 and 3 – 6 under 35 U.S.C. §103(a) over Bruno et al. and Fenton et al. is respectfully requested.

In rejecting claim 9, the Office action acknowledges that "Bruno does not disclose the communications server is a PBX server and the devices have access to all the PBX features." Neither does Bruno et al. or Fenton et al. or any other reference of record for that matter teach "telephonic communications being provided to said digital telephones from remote telephones in cooperation with said PBX server and simultaneously controlled by said remotely connected web enabled devices, wherein said remotely connected web enabled devices have access to all PBX features" as claim 9 currently recites. Similarly with regard to claim 15 the Office action

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acknowledges that "Bruno does not teach a remotely connected web enabled device initiating and controlling the remote telephone [and] Bruno does not disclose having access to all communications." Neither does Bruno et al. or Fenton et al. or any other reference of record for that matter teach that "providing said remotely located web enabled device with access provides said remotely located web enabled device with access to all communications server features" as claim 15 currently recites. As with claims 9 and 15, with regard to claim 20 the Office action acknowledges that "Bruno does not teach the remotely connected device controls the remote telephone or having access to all communications server features."

In applying Fenton et al. to the present invention as recited in claims 9, 15 and 20, the Office action asserts that Fenton et al. teaches "controlling a remote telephone by a remote device in column 5, lines 4 – 10." However, at that location, Fenton et al. teaches a server 12 with a system controller 26 that controls an audio conferencing system 28. Applicants also note that the Fenton et al. system controller 26 or audio conferencing system 28 are not the Fenton et al. PBX 20. While the Office action further asserts that Fenton et al. remote devices issue commands to control the server; other than audio conferencing, e.g., joining a conference call or hanging up, (col. 5, lines 25 – 60), the applicants could not find Fenton et al. to discuss any other commands from remote devices that affected the Fenton et al. system controller 26 or audio conferencing system 28. Moreover, "[e]ach remote computer runs a GUI program which allows a user operating the remote computer to **control the central server to provide information regarding audio conferences and to control other audio conference functions.**" Col. 5, lines 25 – 28 (emphasis added).

Audio conferencing features are quite different than PBX features. Certainly, controlling audio conferencing falls far short of "remotely connected web enabled devices have access to all PBX features" as claim 9 currently recites; providing the "remotely located web enabled device with access to all communications server features" as claim 15 recites; or, "wherein said remotely connected device has access to all communications server features." as claim 20 recites. Nor is this shown or suggested by "an **audio conferencing system** [being] provided which employs an automated central conferencing system such that a human operator is not required," as described by Fenton et al. Col. 3, lines 48 – 50 (emphasis added). Nor is operating "in a

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reduced fashion, in a pseudo multimedia manner” as Bruno et al. describes, *supra*, providing “remotely connected web enabled devices [with] access to all PBX features” as claim 9 currently recites; providing the “remotely located web enabled device with access to all communications server features” as claim 15 recites; or, “wherein said remotely connected device has access to all communications server features.” as claim 20 recites. Therefore, the combination of Bruno et al. and Fenton et al. does not result in nor suggest the present invention, and *prima facie* obviousness has not been established for claims 9, 15 or 20.

Further, since dependent claims include all of the differences with the references as the claims from which they depend, claims 10, 11, or 16 which depend from claims 9 and 15, respectively, are patentable over the combination of Bruno et al. and Fenton et al. Reconsideration and withdrawal of the rejection of claims 9 – 11, 15 and 16 under 35 U.S.C. §103(a) over Bruno et al. and Fenton et al. is respectfully requested.

Neither does Weinstein et al. add what is missing from the combination of Bruno et al. and Fenton et al. to result in the present invention as recited in 1 and 9. Weinstein et al. is relied upon to teach a wireless area protocol (WAP) device connected over the Internet. Thus, the combination of a Weinstein et al. WAP with Bruno et al. and Fenton et al. does not result in the present invention as recited in 1 and 9, much less claims 2, 8, 13 and 14, which depend therefrom. Reconsideration and withdrawal of the rejection of claims 2, 8, 13 and 14 under 35 U.S.C. §103(a) over Bruno et al. and Fenton et al. in combination with Weinstein et al. is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner consider new claims 21 and 22, reconsider and withdraw the rejection of claims 1, 3 – 11, 13 – 16 and 20 under 35 U.S.C. §103(a) and allow the application to issue.

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As the applicants previously noted, MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

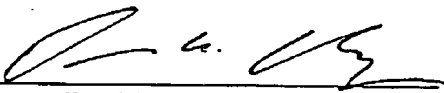
If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney by telephone at (650) 694-5339 for a telephonic interview to discuss any other changes.

Respectfully submitted,

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(Date)

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